

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 11 to 23, claims 1 to 7, 9, 10 and 24 to 26 are pending in the present application. In view of the foregoing following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 2 and 24 to 26 Under 35 U.S.C. § 112, First Paragraph**

Claims 1 to 2 and 24 to 26 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As an initial matter, the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” M.P.E.P. § 2163.04 (citing *In re Wertheim*, 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976)) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of written description, the examiner should “identify the claim limitation not described” and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” *Id.* However, the written description requirement is not an *in haec verba* requirement. That is, “the specification ‘need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.’” *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)).

The Office Action alleges that the “[s]pecification fails to teach an initial solids mixture containing water, adhesive agent or any organic compounds.” Final Office Action at p. 2. Applicant respectfully disagrees and submits that the application as filed provides an adequate written description of the subject matter as presently claimed, including an initial solids mixture containing “an aqueous or water containing organic coating solution” as recited in claim 1. For example, the Specification states at page 2, lines 7 to 10:

It is an object of the present invention to provide an initial solids mixture to the extent that in a coil coating method an aqueous based, or at least a water-containing adhesive agent system may be used.

Further, the Specification states at page 3, lines 34 to 37:

the proportion of adhesive agent to additive particles is in a range such as 1:2 or 1:3, these numerical values being influenced by the density and the particle size of the additive particles used, but also strongly by the adhesive agent.

The Specification states at page 5, lines 33 to 37:

Among the additive particles according to the present invention, there are materials which are also compatible with aqueous or water-containing coating solution, which may be developed neutral, acid or alkaline.

The Specification states at page 6, lines 4 to 6:

[O]rganic, aqueous-based as well as water-containing systems come into consideration as adhesive agent for the additive particles named.

Further, several different initial solids mixtures are described on pages 6 to 8 of the Specification, each including an aqueous or water containing organic coating solution. See page 6, line 14 to page 8, line 35. In regard to the examples described on pages 6 to 8 of the Specification, the Specification states at page 9, lines 1 to 3:

Each initial solids mixture was applied to test metal sheets in varying layer thicknesses, using a doctor blade device, and was thermally hardened.

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are supported by an adequate written description, and withdrawal of this rejection is therefore respectfully requested.

**III. Rejection of Claims 1 to 7, 9 to 10, and 24 to 26 Under 35 U.S.C. § 112, Second Paragraph**

Claims 1 to 7, 9 to 10, and 24 to 26 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention.

While Applicant respectfully disagrees with the merits of this rejection, to facilitate matters, claim 1 has been amended herein without prejudice to clarify the subject matter claimed. In particular, claim 1 has been amended herein without prejudice as follows:

1. An initial solids mixture for a later organic coating, the initial solids mixture comprising:
  - an aqueous or water containing organic coating solution with electrically conductive additive particles, the additive particles including at least one of boron carbide, silicon carbide, a conductive oxide, silicide, carbide of transitional elements, boride of transitional elements and lanthanides,
  - wherein an electrical conductivity of the additive particles is in the metallic range, and
  - wherein the additive particles are configured to have a continuous physical connection in at least one spatial direction.

It is believed and respectfully submitted that claim 1 as presented fully complies with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

**IV. Art Rejections Contained in Office Action of March 6, 2003**

The Final Office Action states at page 3 that if Applicant is claiming an initial solids mixture (as opposed to an aqueous organic coating) then “the art rejections of the Office Action of March 6, 2003 will be reinstated.” This statement is not understood since no Office Action in the present application is dated March 6, 2003. If reference was intended to be made to the Office Action dated March 12, 2003, the Examiner’s attention is directed to the Remarks section of the Amendment filed on June 12, 2003 in response to the March 12, 2003 Office Action. It is nevertheless Applicant’s understanding that the statement that “the art rejections of the Office Action of March 6, 2003 will be reinstated” is not a statement of a present rejection of the presently pending claims and does not constitute a rejection of any of the presently pending claims in compliance with 35 U.S.C. § 132 and 37 C.F.R. § 1.104. Thus, it is Applicant’s understanding that none of the presently pending claims have been rejected in the Final Office Action under 35 U.S.C. § 102 or under 35

U.S.C. § 103. Applicant will respond to any such rejection(s) if and when made in compliance with 35 U.S.C. § 132 and 37 C.F.R. § 1.104.

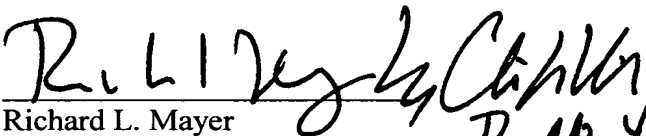
**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: December 10, 2003 By:

  
Richard L. Mayer  
Reg. No. 22,490  
One Broadway  
New York, New York 10004  
(212) 425-7200  
CUSTOMER NO. 26646  
TS, NO. 42,194